

RECOI
TR/

02-13-2003



Docket No.:

2131-65

Tab settings

To the Honorable Commissioner of Patents and

102365077

original documents or copy thereof.

1. Name of conveying party(ies): SHANE JEWELRY CO. 1-22-03

Individual(s) Association
 General Partnership Limited Partnership
 Corporation-State Michigan
 Other _____

Additional names(s) of conveying party(ies) Yes No

2. Name and address of receiving party(ies):

Name: WESTERN STONE AND METAL CORP.

Internal Address: _____

Street Address: 9200 E. Mineral Ave., Suite 200

City: Englewood State: CO ZIP: 80112

Individual(s) citizenship _____
 Association _____
 General Partnership _____
 Limited Partnership _____
 Corporation-State Colorado
 Other _____

If assignee is not domiciled in the United States, a domestic designation is Yes N
 (Designations must be a separate document from
 Additional name(s) & address(es) Yes N

3. Nature of conveyance:

Assignment Merger
 Security Agreement Change of Name
 Other _____

Execution Date: August 1, 2002

Application number(s) or registration numbers(s):

A. Trademark Application No.(s)
4/004111
73/584436

Additional numbers Yes No

B. Trademark Registration No.(s)
1934523
1959461

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Brian D. Wallace

Internal Address: Fairfield and Woods, P.C.

Street Address: 1700 Lincoln Street, Suite 2400

City: Denver State: CO ZIP: 80203

6. Total number of applications and registrations involved: 2

7. Total fee (37 CFR 3.41): \$ 880.00

Enclosed
 Authorized to be charged to deposit account

8. Deposit account number:
501642

DO NOT USE THIS SPACE

02/12/2003 DBYRNE 00000073 74004111

01 Fee: 4521 40.00 OP
 02 Fee: 8352 25.00 OP

To the best of my knowledge and belief, the foregoing information is true and correct and attached copy is a true copy of the original document.

Brian D. Wallace
 Name of Person Signing

B.D.W.
 Signature

January 21, 2003
 Date

Total number of pages including cover sheet, attachments: 11

Refund Ref: 02/12/2003 DBYRNE 0000124225
 CHECK Refund Total: \$15.00

TRADEMARK

REEL: 002670 FRAME: 0518

TRADEMARK ASSIGNMENT

WHEREAS, the **Shane Jewelry Co. (ASSIGNOR)**, a corporation organized and existing under the laws of the State of Michigan, pursuant an Order from the Trademark Trial and Appeal Board of the United States Patent and Trademark Office in Concurrent Use No. 924 (the "Concurrent Use Order"), attached hereto as Exhibit A, has certain concurrent use rights to the U.S. trademark registrations listed in Schedule 1 attached hereto in a four county area within the State of Michigan consisting of the counties of Ionia, Chinton, Ingham and Eaton.

WHEREAS, **Western Stone and Metal Corp. (ASSIGNEE)**, a corporation organized and existing under the laws of the State of Colorado, is the owner of the U.S. trademark registrations listed in Schedule 1 attached hereto (the "Trademarks"), and is desirous of acquiring all of ASSIGNOR's rights, including all concurrent use rights identified in the Concurrent Use Order, and the good will of the business symbolized by the trademarks;

NOW, THEREFORE, for the payment of ONE THOUSAND DOLLARS (\$1,000.00) and up to FIVE HUNDRED DOLLARS (\$500.00) for reimbursement of ASSIGNOR's attorney's fees, and other good and valuable consideration the receipt of which is hereby acknowledged, ASSIGNOR does hereby agree to transfer and assign to ASSIGNEE its successors and assigns at a time at which such marks may be transferred consistent with Title 37 CFR, all right, title and interest in and to said Trademarks and the concurrent use rights set forth in the registrations therefor, together with the good will of the business symbolized by the Trademarks; to be held and enjoyed by ASSIGNEE, its successors and assigns, licensees or other legal representatives, as fully and entirely as the same would have been held by ASSIGNOR had this assignment not been made.

Effective the 1st day of August, 2002.

Shane Jewelry Co., Inc.
a Michigan corporation

By: Gerald D. Shane
Name: GERALD D. SHANE
Title: PRESIDENT

State of MICHIGAN }
 } ss
County of EATON }

Before me personally appeared Gerald D. Shane, to me known to be the person described in the above assignment, who signed the foregoing instrument in my presence, and acknowledged the same to be his free act and deed, on Aug. 1, 2002.

John D. Schneeberger
Notary Public

JOHN D. SCHNEEBERGER
NOTARY PUBLIC EATON CO., MI
MY COMMISSION EXPIRES Jan 4, 2005

My Commission Expires: 1-4-05

SCHEDULE 1

<u>Mark</u>	<u>U.S. Registration / Application No.</u>
Shane Co.	Reg. No. 1934523, SN 74/004111
Shane Co.	Reg. No. 1959461, SN 73/584436

Eastern Stone Trademark Assignment from Shane Jewelry

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2800 Crystal Drive
Arlington, Virginia 22202-3513

Bottorff

Concurrent Use No. 926

Western Stone & Metal
Corp., dba Shane Co.,
concurrent use applicant

v.

Trading Company of
America, Ltd., by change
of name from Shane
Company, Inc.,
concurrent use applicant,

v.

S & R Jewelry Company
West, Inc. (Los Angeles,
California),
excepted user,

v.

Shane Jewelry Co. (Grand
Ledge, Michigan),
excepted user

v.

Shane, Inc. (Warwick,
Rhode Island), excepted
user

MAILED
JUN 06 1995
PAT. & T.M. OFFICE

INTRODUCTION

This concurrent use proceeding involves two concurrent
use applicants, Western Stone & Metal Corp., dba Shane Co.
(hereinafter Western Stone), and Trading Company of America,

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Ltd., by change of name from Shane Company, Inc.

(hereinafter Trading Company).

By order dated November 17, 1994, the Board, inter alia, acknowledged the entitlement of Western Stone to the concurrent use registration it seeks in Application Serial No. 74/004,111. However, the Board found that concurrent use applicant Trading Company had not yet established its entitlement to the concurrent use registration it seeks, vis-a-vis each of the excepted users named in its application Serial No. 73/584,436. The Board allowed Trading Company time in which to submit additional evidence establishing such entitlement.¹

On February 14, 1995, Trading Company submitted its statement of entitlement to registration, in response to the Board's order.² In its statement, Trading Company requested that Shane Inc., (R.I.) be deleted as a named user from application Serial No. 73/584,436 and as a party to this proceeding, and that five other users named in its application be deleted therefrom. Trading Company has also submitted a copy of a settlement agreement between itself and named user Shane Jewelry Co. of Grand Ledge, Michigan, as evidence of its entitlement to a concurrent registration.

¹This order shall use the same abbreviated designations for the various parties and named users involved in this proceeding as were used in the November 17, 1994 order.

²Trading Company's January 17, 1995 request to extend its time to respond to the Board's order is granted.

SHANE INC. (R.I.) DELETED FROM APPLICATION

The Board's November 17, 1994 order allowed Shane Inc. (R.I.) twenty days therefrom to show cause why it should not be deleted as a named user from Trading Company's application and deleted as a party to this case. The record shows no response from Shane Inc. (R.I.). In view thereof, Shane Inc. (R.I.) is deleted as a named excepted user in Trading Company's application Serial No. 73/584,436, and is dismissed as a party to this concurrent use proceeding.

THE FIVE OTHER "SHANE CO." NAMED USERS

The Board's November 17, 1994 order noted that Trading Company had named the following, inter alia, as excepted users: (1) Shane Co., of San Mateo, California; (2) The Shane Co., of Englewood, Colorado; (3) The Shane Co., of Atlanta, Georgia; (4) The Shane Co., of Seattle, Washington; (5) The Shane Co., of St. Thomas, U.S. Virgin Islands. The Board also noted that it appeared from the record herein that these five entities might be related to or encompassed by Western Stone, with whom Trading Company has entered into a settlement agreement which the Board has already determined to be sufficient to entitle Western Stone and Trading Company to concurrent registrations. The Board stated that upon a definitive statement from Trading Company as to the existence of such a relationship between Western Stone and these five entities, the Board will delete those

entities as named users in Trading Company's application.
(See November 17, 1994 order at pp. 8-9.)

Trading Company, in its February 14, 1995 statement, has stated affirmatively that these five entities are owned by, and thus encompassed by Western Stone. In view of this statement (which Western Stone has not contested), those five entities are hereby deleted as named users from Trading Company's application Serial No. 73/584,435.

SHANE JEWELRY CO. OF GRAND LEDGE, MICHIGAN

Finally, in response to the Board's November 17, 1994 order, Trading Company has submitted a copy of a settlement agreement executed by Trading Company and Shane Jewelry Co. of Grand Ledge, Michigan. The agreement is submitted in support of Trading Company's contention that it is entitled to its concurrent registration, vis-a-vis Shane Jewelry Co.

The agreement provides, in relevant part, that Shane Jewelry Co. of Grand Ledge, Michigan will not use or advertise any SHANE marks in the geographic area for which Trading Company is seeking its concurrent registration, i.e., the states of Indiana, Kentucky, Ohio, and Pennsylvania (except for the Philadelphia metropolitan area), and an area encompassed by a radius of eighty miles in all directions from Houston, Texas, and also that Trading Company will not use or advertise any SHANE marks within the four county area in Michigan consisting of the counties of Ionia, Clinton, Ingham and Eaton. The parties agree that

these geographic restrictions on the parties' rights to use their respective marks will be sufficient to avoid likelihood of confusion.

The Board finds that the above-summarized provisions of this agreement are sufficient to establish that concurrent use of the SHANE mark by Trading Company and Shane Jewelry Co., in accordance with the restrictions imposed by the agreement, is not likely to cause confusion, mistake or deception.³

The Board has previously found, in its November 17, 1994 order, that Trading Company's agreements with the other remaining users named in its application, i.e., Western Stone and S & R Jewelry Company West, Inc., are sufficient evidence that confusion is not likely to result from concurrent use of the marks by Trading Company and those parties. Thus, Trading Company has now established its entitlement to the concurrent registration it seeks in application Serial No. 73/584,436, vis-a-vis each of the remaining excepted users named in that application. See *Precision Tune Inc. v. Precision Auto-Tune, Inc.*, 4 USPQ2d 1097 (TTAB 1987).

³The parties to the agreement may wish to review the provisions of paragraph 5 of the agreement, which contains what appears to be a drafting error. Specifically, in line 2 of paragraph 5 of the agreement, the reference to "Paragraph 1" might need to be changed to "Paragraph 2." Alternatively, and also in line 2, the word "outside" might need to be changed to "inside." As currently drafted, Paragraph 5 of the agreement would require Shane Jewelry Co. to withdraw its claim of use of the mark in its home base of Grand Ledge, Michigan, which is a location "outside of the area set forth in Paragraph 1." It is unlikely that the parties intended this result.

SUMMARY

By way of summary (including the orders previously issued in the Board's November 17, 1994 decision), and in termination of this concurrent use proceeding,

IT IS HEREBY ORDERED THAT:

1. Western Stone's application Serial No. 74/004,111 is hereby amended to delete, from page 2, Lines 16 and 17, the following wording: "; and Shane, Inc., 2525 West Shore Road, Warwick, Rhode Island in Warwick, Rhode Island".

2. All references in Trading Company's application Serial No. 73/584,436 to the following named excepted users are hereby deleted and to be given no effect:

- a. Shane Co., Inc., of San Mateo, California;
- b. The Shane Co., of Englewood, Colorado;
- c. The Shane Co., of Atlanta, Georgia;
- d. The Shane Co., of Seattle, Washington;
- e. The Shane Co., of St. Thomas, U.S. Virgin Islands;
- f. Shane, Inc., of Warwick, Rhode Island.

3. Shane, Inc., of Warwick, Rhode Island is hereby dismissed as a party defendant in this concurrent use proceeding.

4. Western Stone & Metal Corp., dba Shane Co., (application Serial No. 74/004,111) is entitled to register the mark SHANE CO., in stylized form, (pursuant to Trademark Act Section 2(f) and subject to a disclaimer of the

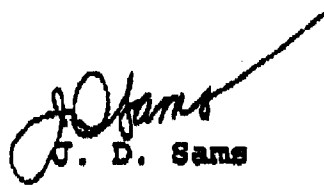
exclusive right to use "CO.") for "jewelry made of precious metals and precious stones," in Class 14, and "retail jewelry store services," in Class 42, for the following geographic area:

The entire United States and its territories except for: the states of Indiana, Kentucky, Ohio and Pennsylvania (except for the Philadelphia metropolitan area); an area encompassed by a radius of eighty miles in all directions from Houston, Texas; the Los Angeles, California metropolitan area; and a four county area within the state of Michigan consisting of the counties of Ionia, Clinton, Ingham and Eaton.

5. Trading Company of America, Ltd.⁴ (application Serial No. 73/584,436) is entitled to register the mark SHANE CO., in stylized form, (pursuant to Trademark Act Section 2(f) and subject to a disclaimer of the exclusive right to use "CO.") for "retail jewelry store services" in Class 42, for the geographic area comprising the states of Indiana, Kentucky, Ohio, and Pennsylvania (excluding the Philadelphia metropolitan area), and an area encompassed by

⁴Trading Company's address of record is Two West Washington Street, Suite 600, Indianapolis, IN 46204. However, it appears from the settlement agreement between Trading Company and Shane Jewelry Co., executed in February 1995, that Trading Company has a new address, i.e., 3900 Keystone Crossing, Suite 1200, Indianapolis, IN 46240. The Board has corrected the Office's records accordingly.

a radius of eighty miles in all directions from Houston,
Texas.


J. D. Sams


J. E. Rice


P. T. Hairston

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

cc:

Trading Company of America, Ltd.
c/o Clifford W. Browning, Esq.
Woodard, Emhardt, et al
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

Western Stone & Metal Corp.
c/o Gary D. Fields, Esq.
Fields, Lewis, et al
1720 S. Bellaire St., Suite 1100
Denver, CO 80222

Shane Jewelry Co.
c/o William L. Ferrigan, Esq.
P.O. Box 27
403 S. Clinton St.
Grand Ledge, MI 48837

S & R Jewelry Company West, Inc.
1015 Broxton Avenue
Los Angeles, CA 90024

Shane, Inc.
P.O. Box 1356
Coventry, RI 02816

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SHANE CO HQ

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RECORDED: 01/22/2003

TRADEMARK
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